

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Charles Patrick Rehberg et al.	Art Unit :	2129
Serial No. :	10/765,461	Examiner :	Joseph P. Hirl
Filed :	January 26, 2004	Conf. No. :	8603
Title :	Rule Selection Engine		

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Commissioner for Patents
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REQUEST FOR SUPPLEMENTARY ACTION AND
RESTARTING OF THE REPLY PERIOD (MPEP 710.06)

Responsive to the action mailed August 17, 2007, the applicant requests a supplementary action and a restarting of the reply period as set forth in MPEP 710.06.

REMARKS

The final non-final office action mailed August 17, 2007, maintains the rejection of the claims over Masui. In response to a notice of panel decision from a pre-appeal brief review, the applicant filed an RCE and substantially amended the claims in order to advance prosecution of this application to issuance. In response, the examiner issued an office action which fails to address the applicant's amendments and arguments. More particularly, the office action addresses the applicant's arguments as follows (emphasis added):

1. Person of ordinary skill in the art (PHOSITA) knows that a classic computer is implemented using binary elements that include gates and memory media. Such implementation is further done with zeroes and ones arranged in groups, elements of such groups are referred to as bits (0/1). Since zeros and ones are numbers grouped together, such representation will of consequence be a vector representing a rule with bits... a rule bit vector. Selection bit vectors are similarly configured and represented. Representation of related information by coding the bit is the process of programming... not new or not non-obvious. Hence, such a limitation claimed by the applicant amount to no limitations since POSITA would of consequence have performed such actions without such identified limitations... just the way it has to be done... the way it has been done for a long time ... nothing novel and for sure quite obvious. Therefore, the examiner considers the instant amendments to the claims to be of neutral or no effect consequence and adding such amendments to the claims below, requires no additional prior art. Hence, such related "wherein" amendments are treated in accordance with MPEP 2111.04 and are not given weight (not incorporated with the claim statements below) because such amendments have no limiting effect.

The applicant respectfully requests that if the rejection over Masui is to be maintained, that the office address with specificity the added limitations in the claims and the arguments presented in the reply of August 8, 2007. In addition, the applicant requests that the examiner reply to each of the enumerated arguments below:

(1) The examiner fails to address the limitations of claim 1 in this rejection.

Specifically, the examiner fails to provide support for his position that Masui teaches that each of the rules comprise a rule bit vector and each condition element is associated with a single bit in the rule bit vector. In addition, the examiner fails to provide support for his position that Masui teaches that “the storage locations for holding values of the condition elements comprise bits of a selection bit vector with each condition element being associated with a different bit position in the selection bit vector.” Based on the limitations included in claim 1, the applicant strongly disagrees with the examiner’s statement that “such a limitation claimed by the applicant amount to no limitations since POSITA would of consequence have performed such actions without such identified limitations... just the way it has to be done ... the way it has been done for a long time ... nothing novel and for sure quite obvious.” Rather, the applicant submits that it would not have been obvious for one of skill in the art to use such a configuration. As such, the applicant requests that the examiner provide documentary support for the rejections.

(2) In the office action dated August 17, 2007, the examiner states “the examiner considers the instant amendments to the claims to be of neutral or no effect consequence and adding such amendments to the claims below, requires no additional prior art. Hence, such related “wherein” amendments are treated in accordance with MPEP 2111.04 and are not given weight (not incorporated with the claim statements below) because such amendments have no limiting effect.” The applicant asserts that the examiner has inappropriately applied MPEP 2111.04. MPEP 2111.04 states that:

“claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure.”

As such, MPEP 2111.04 applies in two situations. First, MPEP 2111.04 applies when claim language suggests or makes optional but does not require steps to be performed. In the present claims, the added limitations are not optional limitations, but rather add a required structure to the rule bit vector and selection bit vector. Secondly, MPEP 2111.04 applies when claim language does not limit a claim to a particular structure. In the present claims, the claim language explicitly limits the structure of the rule bit vector and selection bit vector. As such, the applicant asserts that the limitations added to the claims do not fall within the scope of MPEP 2111.04 and, therefore, should be given patentable weight. Applicant requests that the examiner address the added limitations in a supplemental office action.

(3) It is unclear to the applicant if the examiner is attempting to rely on “official notice” for this rejection. If the examiner is relying on official notice, the applicant would like to note that MPEP 2104.04 states:

If applicant adequately traverses the examiner’s assertion of official notice, **the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.** See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual

statements and explanation to support the finding. See 37 CFR
1.104(d)(2). (emphasis added)

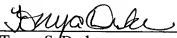
Therefore, if the examiner is relying on official notice, the applicant traverses the
examiner's assertion of "official notice" and requests that the examiner provide
documentary evidence to support the rejections if these rejections are maintained.

(4) In the reply dated August 8, 2007, the applicant requested that the examiner
reply to arguments previously unaddressed. More particularly, the applicant stated "If the
examiner is to maintain the rejection of claim 1, the applicant requests that the examiner
address the reasons presented in the reply to final office action dated January 29, 2007
and the pre-appeal brief dated April 12, 2007." The examiner has failed to provide such
reasons. The applicant again requests that the examiner address these arguments.

Please apply any other charges or credits to Deposit Account No. 50-4189,
referencing Attorney Docket No. 30008-002001.

Respectfully submitted,

Date: 9/28/07



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